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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/631,204

07/31/2003

James E. Selis

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/631,204	Applicant(s) SELIS, JAMES E.	
	Examiner Melanie Tyson	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-64, 67-74 and 76-80 is/are pending in the application.
- 4a) Of the above claim(s) 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-64, 67-74, and 76-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/17/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's amendment received on 17 March 2008. Claim 80 remains withdrawn from consideration.

Response to Arguments

1. Applicant's arguments with respect to claims 61-64, 67-74, and 76-79 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 61, 64, and 77-79 are objected to because of the following informalities: they contain inconsistent language. In claim 61 (lines 12, 23, and 26), "breast tissue" is recited. However, the preamble recites marking a "biopsy site" or the "site of an aspirated cyst." Nowhere does applicant recite that it is specifically used in breast tissue. It is requested that the applicant amend the claims for consistency purposes without adding new matter. It is further noted that the second paragraph under section (iii) seems to be reciting the same limitations as the first paragraph with different wording. Appropriate correction is required. In claim 64 (line 1), replace "arcuate portions" with "--arc segments--". In claim 67, line 1 recites that the clip is "compressible." However, in line 4 and claims 78 and 79, the applicant recites that the arc segments "unfold upon themselves" or perform an "unfolding" function. It is unclear as to how the arc segments unfold upon themselves if they were simply compressed and not folded. It is requested that the applicant amend the claims for consistency purposes without adding new matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 61-64, 67-72, and 76-79 are rejected under 35 U.S.C. 102(e) as being 35 U.S.C. 103(a) as being unpatentable over Hoyns et al. (6,766,186 B1). Hoyns discloses a clip (see entire document) consisting essentially of a first arc segment, a second arc segment, and an apex, wherein the first and second arc segments include a substantially continuous radius, are formed of a single memory shape wire or separate memory shape wires (for example, see column 6, lines 16-26 and column 5, lines 56-60), are symmetrical, are coplanar, are compressible/self-unfolding within the ranges claimed, penetrate tissue via barbs (66; for example, see Figures 14, 16, and 17), and has a largest diameter of less than 5mm (1.5 mm; for example, see column 4, line 56).

Hoyns fails to disclose the first ends of the first and second arc segments project in a direction away from the second ends of the first and second arc segments.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to orient the ends as claimed, since the applicant has not disclosed a clip having first ends projecting away from the second ends provides an advantage, is used for a particular purpose, or solves a stated problem and it appears the prior art clip having first ends projecting towards the second ends would perform equally well.

5. Claims 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyns et al. in view of Voegele (6,425,903 B1). Hoyns discloses a device as described above, however, fails to disclose the clip further includes a coating. Voegele discloses a clip (see entire document). Voegele teaches the clip can be coated with agents to lower friction, stop bleeding, or accomplish any other desired effect (for example, see column 8, lines 30-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Hoyns's clip with a coating comprising a pharmaceutical agent as taught by Voegele.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
June 13, 2008

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773